

REMARKS / ARGUMENTS

The present application includes pending claims 1-28, all of which have been rejected. By this Amendment, claims 3-10 and 13-17 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) as being obvious over Mikkonen in view of Ansell. The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion....," citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

I. The Proposed Combination of Mikkonen in View of Ansell Does Not Render Claims 1-28 Unpatentable

The Applicant now turns to the rejection of claims 1 - 28 as being unpatentable over Mikkonen in view of Ansell.

A. Independent Claims 1 and 18

With regard to the rejection of independent claims 1 and 18 under 103(a), the Applicant submits that Mikkonen does not disclose or suggest at least the limitation of "attempting to identify previously acquired security data associated with the media peripheral, and **if said security data is not found: exchanging information associated with the home; and acquiring security data associated with the media peripheral; and utilizing said acquired security data associated with the media peripheral to facilitate secure communication between the media peripheral and the communication network,**" as recited by the Applicant in independent claims 1 and 18.

The Office Action states the following:

Mikkonen clearly discloses that the data stored in the media peripheral reads on (at least a subset of) information associated with a home (the identifier that includes an address is associated with a home network, col. 7 lines 33-39) and an ordinary artisan would readily recognize that each time that the discussed above media peripheral was implemented in the home environment (home network) the media peripheral would communicate with the network (including communicating with the correspondent node/entity) via a home node (e.g. Home Agent 128, Fig. 3).

See Office Action at page 3. Initially, the Applicant points out that claims 1-28 are rejected under 35 USC 103(a), as being unpatentable over Mikkonen in view of Ansell.

The Examiner refers for support to col. 7, lines 33-39 of Mikkonen, which discloses a module which is releasably engaged with a terminal, with an identifier stored in the module that is associated with the user. The Examiner is equating the module of Mikkonen with the media peripheral of Applicant's claim 1. The module of Mikkonen is not a device which communicates with a communication network, as recited in Applicant's claim 1. The module is disclosed as "a portable storage device," or a "storage element" that stores an "identifier address" and "roams with the location of the user". The storage element is engaged with a terminal to provide an IP address, or other identifier address by which to identify the terminal from which a packet of data is transmitted. There is no disclosure or suggestion of the storage element communicating with the communication network. The storage element does not exchange information associated with the home, as recited in claim 1. Being a storage element, it is accessed by a terminal which reads information such as an identifier address, "the contents of the storage location of the storage element is accessible to the data terminal to retrieve the value of the identifier address stored at the storage location," not an exchange, or two-way transfer of information. Accordingly, Mikkonen does not disclose "attempting to identify previously acquired security data associated with the media peripheral."

There is no disclosure supporting **"if said security data is not found: exchanging** information associated with the home; and **acquiring** security data associated with the media peripheral," as recited in claim 1. In Mikkonen, the storage element is engaged with a terminal to provide an IP address, or other identifier address by which to identify the terminal from which a packet of data is transmitted. Mikkonen does not disclose "exchanging information associated with the home", "if said security data is not found." In other words, Mikkonen does not determine whether "said security data is found."

Furthermore, there is no disclosure in Mikkonen which shows that "a portable storage device" or a "storage element" that stores an "identifier address" and "roams with the location of the user" **exchanges** information with the home. Instead, Mikkonen states that the storage element is **releasably engaged** with a terminal **to provide** an IP address, or other identifier address by which to identify the terminal from which a packet of data is transmitted. Hence, when the storage element is **releasably engaged** with a terminal, the identifier stored in the storage element is provided to the terminal from which a packet of data is transmitted. There is no "exchanging information associated with the home."

The Examiner concedes that Mikkonen is silent as to utilizing said security data associated with the media peripheral to facilitate secure communication between the media peripheral and the communication network, as recited in Applicant's claim 1. In order to satisfy this deficiency, the examiner looks to Ansel for support.

The Examiner attempts to provide support for security data associated with the media peripheral from Ansell, col. 9 line 58 – col. 10 line 55, which discloses a security key that is stored on a portable music player that allows it access to “secure portable tracks”. Ansell does not disclose or suggest “attempting to identify previously acquired security data associated with the media peripheral, and if said security data is not found: exchanging information associated with the home; and acquiring security data associated with the media peripheral; and utilizing said acquired security data associated with the media peripheral to facilitate secure communication between the media peripheral and the communication network,” as recited by the Applicant in independent claims 1 and 18. Ansell does not teach facilitating secure communication, but teaches secure storage and playback of data.

Accordingly, Mikkonen in view of Ansell does not render independent claims 1 and 18 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant believes that the rejection of the independent claims 1 and 18 under 35 USC 103(a), over Mikkonen in view of Ansell has been overcome and respectfully requests that the rejection be withdrawn. The Applicant respectfully submits that claim 1 is allowable. The Applicant respectfully reserves the right to argue additional reasons that support the allowability of claims 1 and 18 should that need arise in the future.

B. Independent Claim 11

The Examiner erroneously mischaracterized claim 11 as a dependent claim and rejected independent claim 11 in a manner similar to and with the rejection for the dependent claims 2-10, 12-17 and 19-28. Based on at least the foregoing, the Applicant believes the rejection of independent claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Mikkonen in view of Ansell has been overcome and requests that the rejection be withdrawn.

Notwithstanding, based on at least the foregoing, the Applicant believes that if a similar rejection as cited for independent claims 1 and 18 were applied to independent claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Mikkonen in view of Ansell, independent claim 11 would be allowable for at least similar reasons stated above.

The Applicant respectfully reserves the right to argue additional reasons that support the allowability of independent claim 11 should that need arise in the future.

C. Rejection of Dependent Claims 2-10, 12-17 and 19-28

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Mikkonen in view of Ansell has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10 depend from independent claim 1, claims 12-17 depend from independent claim 11 and claims

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19-28 depend from independent claim 18, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-17 and 19-28.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-28 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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